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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,291	08/05/2003	Cyrus Pershing Henry	YOUZ 2 00087	7979
27885	7590	09/11/2006	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			TOOMER, CEPHIA D	
		ART UNIT	PAPER NUMBER	
		1714		

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/634,291	HENRY ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,8,9,11,12,15-17,31-39,45 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,8,9,11,12,15-17,31-39,45 and 50-56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This Office action is in response to the amendment filed June 16, 2006 in which claims 1, 8, 11 and 45 were amended.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment to the claims.

The 102 rejection of the claims under 35 USC 102(b) over Caprotti is withdrawn in view of the amendment to the claims.

The 103 rejection of the claims under 35 USC 103 over Jackson is withdrawn in view of the amendment to the claims.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because it is not clear if the strikethrough on the penultimate line of the claim is correct.

Claim 56 is rejected because a polymeric group comprising at least 12 carbon atoms does not equate to a molecular weight of 500 to 2500.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8, 9, 11, 12, 15-17, 34, 35, 45 and 50-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Machleider (US 4,134,846).

Machleider teaches a fuel composition comprising a polyalkylene phenol (see abstract), wherein the phenol is present in the fuel at a concentration of about 100-650 ppm (see col. 1, lines 36-46). The polyalkylene substituent has a molecular weight of about 500-3000 and may be polyisobutylene (see col. 7, lines 23-35). The fuel may be jet fuel and may contain antioxidants and metal deactivators (see col. 9, lines 47-64; col. 10, lines 1-2). Machleider inherently teaches the method of claims 45 and 53-33 because he teaches the same fuel composition used in the same environment.

Accordingly, Machleider teaching all the limitations of the claims anticipates the claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 31, 32 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machleider (US 4,134,846) in view of Knapp (US 3,145,176).

Machleider has been discussed above. Machleider fails to teach that the antioxidants of his invention are phosphonates. However, Knapp teaches that C<sub>1</sub>-C<sub>12</sub> dialkyl phosphonates (dilauryl) are used as antioxidants in hydrocarbon fuels (see col. 2, lines 1-9; col. 4, line 54 through col. 5, lines 1-8).

It would have been obvious to one of ordinary skill in the art to include phosphonates in the fuel composition because Machleider teaches that conventional antioxidants may be present in his fuel composition and Knapp teaches that phosphonate antioxidants are used to stabilize fuel compositions such as those of Machleider.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machleider in view of EP 482 253.

Machleider has been discussed above. Machleider fails to teach the claimed metal deactivator. However, EP teaches this compound in a hydrocarbon fuel composition (see page 2, lines 1-3; page 7, lines 26-36).

It would have been obvious to one of ordinary skill in the art to have selected the claimed metal deactivator because Machleider teaches a conventional metal deactivator may be present in his composition and EP teaches that N,N-disalicylidene 1,2-propanediamine is a conventional metal deactivator that is used in fuel compositions.

6. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that the claims have been amended such that the claimed

phenolic additive is the phenolic compound and not the phenolic compound mixed with one or more other compounds.

The examiner disagrees. The claims are drafted using the transitional term "comprising" which opens the claims to other components even in major proportions.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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